

Practitioner's Docket No. 1582.34

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In application of: WATABE et al., Junya

Application No.: 10/775,862

Group No.: 1755

Filed: 02/10/2004

Examiner: C. M. Koslow

For: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

PETITION FOR REVIVAL OF AN APPLICATION
FOR PATENT ABANDONED UNINTENTIONALLY UNDER
37 C.F.R. § 1.137(b)
AND ALTERNATIVELY

RECONSIDERATION OF DISMISSAL OF PETITION TO WITHDRAW HOLDING OF
ABANDONMENT - NONFINAL OFFICE ACTION NOT RECEIVED

1. This application became abandoned on October 7, 2005.
2. This application became abandoned because the failure to prosecute was an unintentional delay caused by the non-receipt of an office action to the undersigned representative. The entire delay in filing the required reply from the due date until the filing of this petition was unintentional (37 C.F.R. § 1.137(b)(3)). Please see explanation that the office action was simply never received in the mail.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is *mandatory*;
Express Mail certification is *optional*.)

I hereby certify that, on the date shown below, this correspondence is being:

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G deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

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37 C.F.R. § 1.10*

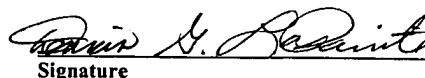
X as "Express Mail Post Office to Addressee"

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TRANSMISSION

G facsimile transmitted to the Patent and Trademark Office, (703) _____.

Date: 1/25/06


Signature

Dennis G. LaPointe

(type or print name of person certifying)

01/27/2006 LWONDIM1 00000017 503368 10775862

01 FC:1453 1500.00 DA

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

I hereby state:

- (a) The Office Action indicated was mailed on April 7, 2005 and was not received. Examiner Koslow telephoned the undersigned representative on November 14, 2005 and asked if the application had been abandoned. The examiner confirmed that the office action was mailed to the former Mason Law, PL at 17757 US 19 North, Suite 500, Clearwater, Florida. [I later realized that it actually was mailed to me as an individual to the US Highway 19N address and the address did not include reference to Mason Law.] A review of the file jacket and docket record at both Mason Law and LaPointe Law reflected that the last action was the submission of the missing part response on May 14, 2004 as evidenced by the Mason Law docket entry, a copy of which has been submitted to the Petitions Branch.

The undersigned maintained customer number 24040 when Mason Law, PL was reorganized and the undersigned representative formed his own office as LaPointe Law Group, PL and relocated to its current Tarpon Springs, Florida address on January 1, 2005. The new address was changed ONLINE with an EBC address update in late December 2004. Further, on June 15, 2005, a paper submission of the same address for correspondence change was submitted to the Patent Office reflecting the P.O. Box 1294, Tarpon Springs, FL 34688 address. This was done despite the online update because in another case, I had responded to an office action in the January/February timeframe using my new address and despite this, a subsequent action was mailed to the former Mason Law address. The examiner in that case had informed me that the docket clerks often revert back to the original filing address without checking for Customer No. updates in mailing to applicant's address. In fact, in US application 10/411,983, an office action was mailed to the former Mason Law address in December 2005, despite the fact that a customer no. update was done in December 2004 and a change of correspondence address was filed in June 2005. Yet had someone at the Post Office returned the action to the patent office instead of redelivering it to Mason Law, then it too would have become abandoned and it would have cost me \$400.00 to withdraw the abandonment due to a mistake by the docket clerk in not checking the customer number updates or for changes in address using a direct filing. It is something fundamentally unfair for a practitioner to be penalized when the PTO has a process for updating addresses for cases already assigned to a customer number and the docket clerks do not do a quick cross-check with the PAIRS or PALM system to verify the address before completing the mailing process. There should be warning when updating an address for a customer number online with the EBC that examiners and docket clerks make no reference to the EBC update and continue to use the old address. Interestingly, the update was caught in most applications by the docket clerks. **(SEE MY SUPP. DECLARATION RE: TELCON W/EBC)**

Mason Law, PL in January reestablished itself as a trademark and copyright practice and the LaPointe Law office remains affiliated with Mason Law and handles all patent matters formerly handled by Mason Law. The undersigned has checked with the Mason Law office and it has no record of receiving the office action. For other files, Mason Law has regularly forwarded received actions to my office (although not many were sent there). Most actions have been sent to the undersigned new address since the change of address was made ONLINE with the EBC in late December 2004.

- (b) In the transition period, the undersigned representative has been using the docket system printed out from the Mason Law office at the end of December 2004, and as new actions are received, the undersigned has been entering the new data in its own docket. A search

of the file jacket and the docket records in both offices indicates that this Office Action was not received. A copy of the docket record at Mason Law is attached and confirms that the last entry was for responding to the Missing Parts requirement. The undersigned has also now created a docket entry for this case in his own case docketing system and has initially entered an action to respond to the 14 November 2005 telephonic advisory from the Examiner that the application is being held abandoned for failure to respond to a non-final office action (that was not received).

- (c) Petition examiner Hearn is apparently under the belief that a spreadsheet had to be filed with the EBC to include this case as he checked with the EBC to see if one was filed and now he wants proof that one was filed. Frankly, I respectfully do not understand the relevance of this inquiry and request. Spreadsheets are filed when a filed case is not assigned to a customer number. The spreadsheet is submitted with a diskette. **THIS IS NOT THE CASE.** The application has always been assigned to my customer number 24040. Therefore, an online update should have been sufficient to reflect a new mailing address for all cases assigned to customer number 24040 and in most cases, it was sufficient.
 - (d) In addition, the petition examiner Hearn states that it is possible that it was lost between the mailing to my office from Mason Law. Irrespective of the fact that Mason Law would fax me pre-mailed copies, the point is that any delivery to Mason Law was improper for any previously assigned customer number cases as Mason Law no longer had the customer number. I maintained the number for my firm at my new address, which was updated with the EBC using the online option. Therefore, I submit that any delivery to Mason Law on a case, which was clearly assigned to my customer number after December 2004, was an improper mailing by the patent office. Further, it could not have been mailed to me by Mason Law as Mason Law personnel declare under penalty of perjury that it was never received at its new address. Mailed was still being forwarded to Mason Law at its new address in April 2005 but the 6 month forwarding must be processed by the Post Office, a governmental agency. If it was inadvertently left at the old building, then its current occupants may have discarded it or it may have been sent back to the patent office. Apparently mail returned to the patent office is not sent back to the examiner to verify the mailing address.
- 3. The docket record from Mason Law, which indicates only actions in 2004, as well as the docket record from LaPointe Law where the non-received Office Action would typically have been entered had it been received and docketed. The docket entries (task and deadline reminders) indicate that the last official action which was responded to was the Missing Parts response on May 14, 2004. (See previously submitted Petition of November 15, 2005, which is incorporated by reference herein).
 - 4. As additional evidence of non-receipt of the Office Action, I also attach:

Statements from the person(s) who would have handled the Office Action had it been received along with comments below. (See previously submitted Petition of November 15, 2005, which is incorporated by reference herein). Also please see declaration of Season Turner herein.

Please note that Ms. Season Turner states that because office actions are time sensitive, it was her practice that any office action received would have first been faxed to 727-943-9002, the fax number for LaPointe Law, followed by mailing the confirmation copy to my office. I did not

receive any office action related to this application at any time during the year 2005 by fax or by mail. Petition examiner Hearn indicates that the previously filed declaration of Ms. Miller is not dispositive because the office action could have been lost in the re-mailing to LaPointe Law. He also states that there is no record of an entry in the file jacket or docket records at Mason Law. Mason Law did not have the file jacket, I had possession of the file jacket in Tarpon Springs. Mason Law had no reason to formally enter actions in its docket system on my file where office actions were being first faxed to me and then confirmation copies mailed. Even if a confirmation copy was lost, I would have received the fax copy. Also, the examiner states that there is no adequate proof of non-delivery to Mason Law. Maybe, it was not delivered there because the mailing address did not include the Mason Law firm name as mentioned below. Irregardless of this however, as noted above, this case was assigned to my customer number in February 2004 and all mailings should have been sent to the updated customer address for cases already assigned to it. The update was done ONLINE in December 2004.

Further, in January 2005, the Mason Law firm moved to a new address about 1 mile south of the former office on US Hwy. 19N. The new address is 4755 East Bay Drive, Clearwater, FL. The post office has regularly forwarded the mail to the new Mason Law address. However, a contributing factor is that the office action was mailed to me individually at the old Mason Law address and it did not include the firm name "Mason Law" in the address. It is possible then that the office action was delivered to another business, a vacant office or most probably returned to the patent office.

In the petition to withdraw the holding of abandonment for office action not received, the petition examiner states that he checked with the EBC to see if I ever filed a new spreadsheet adding the case to customer number 24040, and concludes that proof the submission must be provided with a reconsideration request. The examiner has missed the point.

As mentioned above, the case had been associated with customer no. 24040 from the date of filing on 10 February 2004. Therefore, a new spreadsheet was not required. I maintained the customer no. 24040 when I moved to Tarpon Springs on January 1, 2005. Therefore, a new spreadsheet was not required. All that was needed was to update the address and this can be done online by inputting the "Customer No. Data Change." I, in fact, updated the customer no. 24040 online in the mid-December 2004 timeframe. Soon thereafter, most office action were in fact being mailed to the new Tarpon Springs address, in some cases, starting the last week of December 2004. Query: If the only way to update an address under the customer no. is by submitting a spreadsheet to the EBC, then why does the EBC allow the online submission to add personnel, to change address, etc.? A new spreadsheet would have been required when the case was NOT associated with the customer number BUT, in this case, it was associated with my customer number 24040 since the filing date.

This is a case that was referred to the undersigned by a law firm in Japan. As the USPTO must understand, we have an obligation to advise the client of action from the PTO. It has always been my policy to forward an office action to a client within 1 business day of its receipt. I have never ever deviated from this policy. In fact, when the group art examiner (C.M. Koslow) called me and asked if we ever filed a response, I checked the file jacket, confirmed we had no record of an action. She faxed me a copy of the action and I was also able to obtain a copy of action through PAIRS about the same time she faxed it to me. I immediately forwarded the action to the client on that day (see copy of email to client dated 11/14/2005). The next morning (11/15/2005), I filed the petition to withdraw the holding of abandonment. Further, it would have been incumbent on the undersigned to process a received office action expeditiously to the client as

claims were deemed allowable. As one can see by the filing of a response on December 28, 2005, applicant and the undersigned filed a very diligent response to advance the case to allowance pending the decision of the Petitions Branch.

Also, please note that throughout 2005 and continue to do so today, I regularly (on a daily basis), checked PAIRS for outgoing correspondence. This office action was never listed as outgoing correspondence within last 7 days or 30 days. Therefore, the patent office did not scan it in to be associated with this search means.

5. Response or action required is attached.

In connection with the required reply which is required by this petition, please note that the response is by the filing of a request for continued examination in compliance with ' 1.114. The attached request for continued examination is essentially the same response filed on December 28, 2006, except herein converted to a RCE filing under 1.114.

6. Fee (37 C.F.R. § 1.17(m))

Application status is other than small entity—fee \$1,500.00.

7. Payment of fee

Authorization is hereby made to charge the amount of \$1,500.00 to Deposit Account No. 503368.

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate copy of this petition is attached.

8. Terminal Disclaimer

Since this application is a utility application filed after June 8, 1995 a terminal disclaimer is not required.

9. **I check the PAIRS outgoing mail daily and have done this task religiously since moving to my new Tarpon Springs location and no indication was ever provided by the PAIRS system using the "View Outgoing Correspondence Notification" feature as a search means. When the Examiner called me, I advised her that I routinely (daily every morning) checked the PAIRS for outgoing correspondence notifications and that no evidence of such outgoing correspondence was ever posted. (Had the office action been keyed to be presented when I checked PAIRS daily for new outgoing correspondence notifications, then this whole issue would be moot and by now the client would have a notice of allowance. It was not so keyed.) When the Examiner called, a complete check of the file jacket was made with no findings of an action having been received, and given that Mason Law routinely faxed all office action to my fax number before also mailing the confirmation copy and again no fax was ever received and no office action was ever received by mail as well, that customer no. 24040 was associated with the case from 10 February 2004 and the address of the customer number was updated by submitting the new address ONLINE in mid-December 2004, that Mason Law was not a proper addressee for this case as it was not associated with customer no. 24040 since mid-December 2004, that I exercised due diligence in processing the action with the client and responding as soon as reasonably possible, that the action was mailed to me as an**


individual to the former Mason Law address on Hwy. 19N, which may have been the reason why it was not forwarded to the new Mason Law address on East Bay Drive, that docket clerks at the PTO occasionally do not cross-check for new addresses in the file or on the PAIRS or PALM system for customer number updates, that returned mail to the Patent Office apparently does not get re-routed to the examiner to check if addresses have changed, clearly confirms that the office action was simply NOT received and that such non-receipt was beyond the control and not the fault of the undersigned. No other conclusion can be reached.

Accordingly, the undersigned respectfully ask that in lieu of the punitive high hardship cost incurred in filing this petition to revive for unintentional abandonment of the application, that reconsideration of the dismissed petition for withholding abandonment due to nonfinal office action not being received be instead granted and the decision of petition examiner Hearn be reversed. In this case, it is respectfully requested that the holding of abandonment be withdrawn and a new office action issued allowing a three-month statutory period in which to respond without extension fees or the amendment filed 28 December 2005 be processed and entered without incurring RCE filing fees incurred with the RCE amendment filed herein or that the response filed on December 28, 2005 be entered and processed.

Alternatively, then the undersigned ask that the instant petition be granted as a petition based on unavoidable grounds.

I declare under penalty of perjury that the above statements/comments are true to the best of my knowledge and belief and **I sincerely ask for relief from the patent office that minimizes the cost incurred in this unfortunate dilemma.** Clearly, the mailing system and address verification cross-checking process as it relates to data changes with the Customer No. at the patent office may have significantly contributed to the dilemma. Accordingly, I ask for fairness and understanding as well as relief from this financial predicament that has resulted from an office action not having been delivered to me.

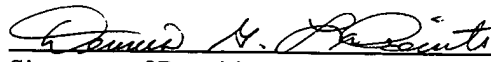
Date: 1/25/06


Signature of person making statement that
abandonment was due to unintentional delay

Dennis G. LaPointe
LaPointe Law Group, PL
P.O. Box 1294
Tarpon Springs, FL 34688

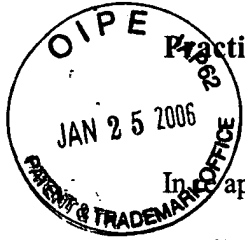
Date: 1/25/06

Reg. No.: 40,693
Tel. No.: 727-943-9300
Customer No.: 24040


Signature of Practitioner
DENNIS G. LAPOINTE
LAPOINTE LAW GROUP, PL
P.O. BOX 1294
TARPON SPRINGS, FL 34688

01-26-06

DAE
J



Practitioner's Docket No. 1582.34

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In application of: Junya WATABE et al.

Application No.: 10/775,862

Group No.: 1755

Filed: 02/10//2004

Examiner: C. M. Koslow

For: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

Mail Stop: Petitions

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

EXPRESS MAIL CERTIFICATE

"Express Mail" label number: EQ 050229122 US

Date of Deposit: January 25, 2006

I hereby state that the following *attached* paper or fee

Petition for revival of an application for patent abandoned unintentionally including declaration of Season Turner and copy of 11/14/2005 email to KABASAWA & Associates.

Copy of Petition Decision of January 19, 2006

RCE Amendment Transmittal

RCE Response after nonfinal office action

Supplemental Combined Declaration and Power of Attorney

Supplemental Declaration of Dennis G. LaPointe

Express Mail Certificate

Post Card

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dennis G. LaPointe

Signature of person mailing paper or fee

Patitioner's Docket No. 1582.34

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: Junya WATABE et al.

Application No.: 10/775,862

Group No.: 1755

Filed: 02/10/2004

Examiner: C. M. KOSLOW

For: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

DECLARATION IN SUPPORT OF PETITION TO WITHDRAW HOLDING OF
ABANDONMENT— OFFICE ACTION NOT RECEIVED

I, Season Turner, a legal assistant at Mason Law, PL at 4755 East Bay Drive in Clearwater, Florida hereby declare:

I have been asked by Dennis G. LaPointe to provide a statement regarding the above-referenced patent related matter apparently erroneously mailed to Dennis G. LaPointe at our former Mason Law address at 17757 US Hwy. 19N in Clearwater, Florida, instead of directly to Mr. LaPointe at his Tarpon Springs, Florida, address. Typically, any document received by Diane Miller, another legal assistant at Mason Law, or myself, were first identified as to whether it was a time sensitive document, typically documents that require a response within a required timeframe. Office actions, maintenance fee reminders, letters from clients wanting a response, etc., are typical of such documents. Once identified as such, I would fax any such documents to Mr. LaPointe at 727-943-9002 and then mail a confirmation copy to him at his Tarpon Springs address, which is about 18 miles north of our current East Bay address. Other than in the first few months, we received very few documents that needed to be forwarded to Mr. LaPointe and because many of our clients are also clients of Mr. LaPointe, we are very conscious of the need to get time sensitive documents to Mr. LaPointe. I would not have docketed any actions that arrived as the patent file jackets are now with Mr. LaPointe and any docketing of new actions as of January 1, 2005 is being done in his office.

I declare under penalty of perjury that the above is true and correct to the best of my knowledge and belief.

1/24/06
Date

Season Turner
Season Turner, Legal Assistant



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Alexandria, VA 22313-1450
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DENNIS G. LAPOINTE
LAPOINTE LAW GROUP, PL
PO BOX 1294
TARPON SPRINGS FL 34688-1294

COPY MAILED

JAN 19 2006

OFFICE OF PETITIONS

In re Application of: :
Watabe et al. :
Application No. 10/775,862 : ON PETITION
Filed: February 10, 2004, :
Docket No.:1582.34 :

This is a decision on the petition filed November 15, 2005, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment.

The petition is dismissed. Any request for reconsideration of this decision must be filed within TWO MONTHS of this mailing. See 37 CFR 1.181(g). Extensions of this period under 37 CFR 1.136(a) are not available.

This application apparently became abandoned for failure to reply to the Office action of April 7, 2005, which set a shortened statutory period for reply of three months. As no reply was received and no extensions of time were received, the application became abandoned at midnight July 7, 2005.

Petitioner requests withdrawal of the holding of abandonment on the grounds that the Office action was never received at either the [obsolete] address to which it was mailed: Mason Law 17757 US 19 North Suite 500, Clearwater Florida, ("Mason") or at the above-captioned address which became effective January 1, 2005. Petitioner contends that a request for a change of correspondence address herein had been presented to the USPTO Electronic Business Center ("EBC") for association with customer number 24040 in late December 2004. Petitioner supplies copies of docket records where the non-received Office action would have been entered had it been received and statements from both firms that a review of the file jacket and docket records at both locations establishes that the last communication received from the USPTO for this application was a Notice Of Missing Parts that was replied to on May 14, 2004.

Initially, the Office action which was mailed to Mason, notwithstanding petitioner's assertion that a change of address was sent to the EBC in late December of 2004, actually appears to have

been mailed to the correct address. The undersigned has contacted the EBC for assistance in this matter. The EBC did receive 4 spreadsheets for customer number 24040 in late November and December of 2004, but is unable to find any spreadsheet listing 10/775,862. The spreadsheets were received November 29, 2004, December 15, 2004, and 2 were received on December 23, 2004, that had reports sent to counsel on January 13, 2005, January 20, 2005, February 2, 2005, and March 1, 2005, respectively. EBC has also confirmed that no notification was sent to counsel which indicated that a requested change of address for customer number 24040 that referenced this application could not be processed. Therefore, a copy of the spreadsheet that counsel sent to the EBC in late December 2004, that included this application number is requested for any renewed petition. *- Done ONLINE. IT person should be able to see when changed online.*

Accordingly, a review of the written record indicates no irregularity in the mailing of Office action of April 7, 2005, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to counsel at the Mason address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must consist of:

- (1) a first-hand statement from the practitioner stating that the action was not received by the practitioner,
- (2) his attestation to the fact that a search of the file jacket and docket records indicates that the Office action was not received, and
- (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioners' statement. See MPEP 711.03(c) subsection I.

It is further not clear that a copy of the docket records has been supplied. That is, the photocopies supplied from both addresses appear to actually correspond to the electronic *file jacket* records that are strictly limited to papers and tasks for this application, and are not indicative of all correspondence received at Mason or counsel's current address with a few days of the mailing of the office action of April 7, 2005. Further, the statement of Ms. Diane Miller is to the effect that any correspondence for this application received at Mason on and after the January 1, 2005, restructuring would have been re-mailed to counsel at the above-captioned address. Ms. Miller does not state that correspondence for counsel received at Mason on or about April 7, 2005, would also have been entered into the Mason file jacket and docket records. Thus the absence of any entry for this application in either the file jacket or, even if shown, the docket records, for this application at Mason is not dispositive. There is not adequate proof on non-receipt at Mason, and the Miller declaration, coupled with the showing at the above-captioned address also raises the possibility that the correspondence could have been lost either at Mason or in the remailing to the above-captioned address after its receipt at

Mason. It remains petitioner's burden to adequately establish non receipt of the April 7, 2005, Office action at the Mason address to which the correspondence was correctly mailed.

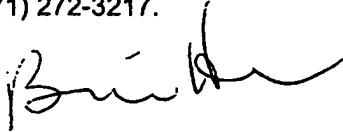
Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Randolph Building 401 Dulany Street
 Alexandria, VA 22314:

By fax: (703) 872-9306
 ATTN: Office of Petitions

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.

A handwritten signature in black ink, appearing to read "Brian Hearn", written over a horizontal line.

Brian Hearn
Petitions Examiner
Office of Petitions

**COPY****Dennis G. LaPointe**

From: Dennis G. LaPointe [dlapointe@lapointelaw.com]
Sent: Monday, November 14, 2005 2:30 PM
To: office@kabasawa.com
Cc: 'Robin Dee Carter'
Subject: Office Action
Attachments: 1582c34.office action.pdf

November 14, 2005

Satoshi KABASAWA
KABASAWA & ASSOCIATES
NSO BLDG., 1-22, Shinjuku 3-chome, Shinjuku-ku
Tokyo 160-0022 JAPAN

Re: Applicant: J. WATABE et al.
Title: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD
Application Ser. No.: 10/775,862
Filed: 02/10/2004
Y/R: FB03134PUS
O/R: 1582.34

Dear Mr. KABASAWA:

We have just received a telephone call from the Examiner asking if the application was abandoned. This was a total surprise. We have never received an office action. She has sent me the action that was mailed on April 7, 2005 and was apparently lost in the mail. Technically, the application now has a holding of abandonment that can be withheld.

We have discussed the matter with the examiner and are in the process of petitioning the patent office to reissue the office action with another three months to respond to it. There is a \$400.00 fee for withholding the abandonment and issuance of another office action for office actions not received.

In the interim, we enclose a copy of the office action, which appears to indicate allowable claims. On the issue of the declaration, the examiner now understands that the declaration submitted is not a supplemental declaration but is rather an executed copy of the original declaration. She has indicated that she will waive the office action issues raised on page 2 as it applies to the declaration.

Claim 1 has been rejected and this rejection can be overcome with the amendment suggested by the Examiner.

Please review the claims 2 and 3 rejections on pages 2 and 3 and provide us your instructions on claim amendments, as well as to the issue of non-support for claim 2. We will file the response as soon as we receive the newly issued office action with new dates.

We appreciate the opportunity to be of service to you and sincerely apologize for the non-receipt of the office action from the patent office. Although lost mail is not uncommon, it is generally rare.

Sincerely,

Dennis G. LaPointe

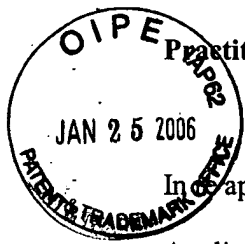
1/23/2006

Dennis G. LaPointe
Registered Patent Attorney
IP Department
Firm Membership: AIPLA, FICPI

LaPointe Law Group, P.L.
P.O. Box 1294
Tarpon Springs, FL 34688-1294
Tel: (727) 943-9300
Fax: (727) 943-9002
e-mail: DLaPointe@lapointelaw.com

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623 East Tarpon Avenue
Tarpon Springs, FL 34689

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Practitioner's Docket No. 1582.34

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In application of: Junya WATABE et al.

Application No.: 10/775,862

Group No.: 1755

Filed: 02/10/2004

Examiner: C. M. KOSLOW

For: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

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**SUPPLEMENTAL
DECLARATION IN SUPPORT OF PETITION TO WITHDRAW HOLDING OF
ABANDONMENT— OFFICE ACTION NOT RECEIVED**

I, Dennis G. LaPointe, an attorney at LaPointe Law Group, PL at P.O. Box 1294 in Tarpon Springs, Florida 34688 hereby declare:

On January 25, 2006, I telephoned the EBC Center and spoke to Moe in technical support for PAIRS, etc. He authorized me to pass on the following information.

I advised him of the statements made by Petition Examiner Hearn regarding checking with the EBC Center and his requirement to show proof of filing a spreadsheet with diskette.

He told me that after checking the instant application, it is clear that the PTO record reflects that the above application was assigned to customer number 24040 from its filing date as the transmittal documents of record clearly designate the attorneys of record to be associated with Customer No. 24040.

He said that under the circumstances, the filing of a spreadsheet is not a proper action as this is done only when a filed case has not been associated with the customer number and the attorney of record files the spreadsheet to obtain the association so access through PAIRS is possible.

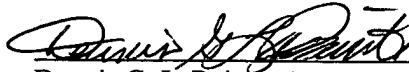
He said that updating the address change in December 2004 was the proper action for me to take.

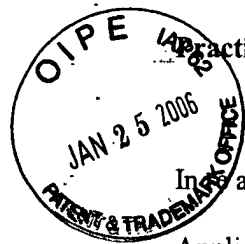
He said it was incumbent on the group clerk to check for any customer number data changes such as address changes for cases already associated with the customer number, more specifically, he said that in April, 2005, a check for any customer number data changes would have alerted the group clerk to mail the office action to the new address.

He said to emphasize to the Petitions Branch that the instant application has always been associated with the customer number 24040, that the online update I made was a proper action and that the Group Clerk should have picked up the new address when mailing the office action.

I declare under penalty of perjury that the above is true and correct.

1/25/06
Date


Dennis G. LaPointe, Attorney of Record
Reg. 40,693
Customer No.: 24040



Practitioner's Docket No. 1582.34

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In application of: Junya WATABE et al.

Application No.: 10/775,862

Group No.: 1755

Filed: February 10, 2004

Examiner: C. M. Koslow

For: ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

Mail Stop RCE

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REQUEST FOR CONTINUED EXAMINATION (RCE)
(37 C.F.R. § 1.114)

1. Applicant hereby requests continued examination, in accordance with 37 C.F.R. § 1.114, for the above identified application.

TIME REQUEST IS BEING MADE

2. This request is being submitted:

This RCE is being filed concurrently with a Petition to Revive Patent Application Abandoned Unintentionally.

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is *mandatory*;
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

G deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

G with sufficient postage as first class mail.

37 C.F.R. § 1.10*

X as "Express Mail Post Office to Addressee"

Mailing Label No. EQ 050229122 US (mandatory)

TRANSMISSION

G facsimile transmitted to the Patent and Trademark Office, (703) _____ - _____.

01/27/2006 LWONDIM1 00000029 503368 10775862

01 FC:1801 790.00 DA

Date: 1/25/06


Signature

Dennis G. LaPointe

(type or print name of person certifying)

* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

ENCLOSURES

3. Enclosed herewith is:

An amendment

FEE FOR REQUEST (37 C.F.R. § 1.17(e)).

4. This application is on behalf of other than small entity.

Continued Prosecution Request Fee: 790.00

FEE FOR CLAIMS

5. The fee for claims (37 C.F.R. § 1.16(b)-(d)) has been calculated as shown below:

	(Col.1)	(Col. 2)	(Col. 3)	OTHER THAN A SMALL ENTITY		
	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDIT. FEE	
TOTAL	3	– 20	= 0	x \$ 50.00	= \$	0.00
INDEP.	2	– 3	= 0	x \$ 200.00	= \$	0.00
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+ \$ 360.00	= \$	0.00
TOTAL ADDIT. FEE					\$	0.00

No additional fee for claims is required.

EXTENSION OF TIME

6. The proceedings herein are for a patent application, and the provisions of 37 C.F.R. § 1.136(a) apply.

Applicant believes that no extension of time is required. However, this is a conditional petition and authorization to pay the necessary fees to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

TOTAL FEE(S) DUE

7. The total fee(s) due is/are:

Continued Prosecution Fee (Section 1.17(e))	\$790.00
Fee(s) for additional claims (Section 1.16(b)-(d))	\$0.00

Total Fee(s) Due:

\$790.00

PAYMENT OF FEE(S) DUE

8. Please pay the fee(s) for this continued examination application as follows:

Charge Account 503368 the sum of \$790.00.

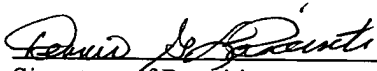
Please charge any required additional fee(s) for § 1.17(e), § 1.16(b)-(d) and/or § 1.17(a)(1)-(4) to Account 503368.

INVENTORSHIP

9. This application as amended names as inventors the same inventors as previously designated for the claims.

Date: 11/25/06

Reg. No.: 40,693
Tel. No.: 727-943-9300
Customer No.: 24040



Signature of Practitioner
DENNIS G. LAPOINTE
LAPOINTE LAW GROUP, PL
P.O. BOX 1294
TARPON SPRINGS, FL 34688

Note! No change from submission of 12/28/05
except resubmitted as RCE with Petition.

ATTORNEY DOCKET NO.: 1582.34

CUSTOMER NO.: 24040

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Junya WATABE et al.)	
)	
S.N.: 10/775,862)	Examiner: C. M. Koslow
)	
Filed: 10 Feb 2004)	Art Unit: 1755
)	
For: Electroluminescent Phosphor and Its)	
Production Method)	
_____)	

Certificate of Express Mail Under 37 C.F.R. 1.10

"Express Mail" mailing label number: EQ 050229122 US

Date of Deposit: 25 JAN 2006

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Dennis G. LaPointe

REQUEST FOR CONTINUED EXAMINATION
UNDER 37 CFR 1.114

M/S: Box RCE (FEE)
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the (NON-FINAL) Examiner's Action mailed April 7, 2005 but never received by applicant, and subsequently declared abandoned for which a Petition is pending with the Petitions Branch, the above-identified patent application is amended as follows:

AMENDMENT A
(37 C.F.R. 1.114)

IN THE CLAIMS:

Please amend claims 1-3 in accordance with 37 C.F.R. 1.121.

The claims are attached herein on separate sheets.

AMENDMENT TO CLAIMS

[Deleted material is struck-through and added material is underlined]

1. (Currently Amended) Electroluminescent phosphor comprising:
 - a host material which ~~can be~~ **is** represented by the formula $\text{ZnS} \cdot a\text{AO}$, wherein "A" is at least one element selected from among magnesium (Mg), calcium (Ca), strontium (Sr), and barium (Ba), and "a" ranges from 0.001 to 0.01;
 - either one of or both copper (Cu) or manganese (Mn) as an activator; and
 - at least one element selected from among chlorine (Cl), bromine (Br), iodine (I), and aluminum (Al) as a co-activator.
2. (Currently Amended) An electroluminescent phosphor production method comprising:
 - a primary firing process for firing at a temperature in the range of 1150 to 1350 °C a mixture produced by adding to zinc sulfide (ZnS):
 - at least one kind of compounds selected from among copper compounds and manganese compounds as a material of an activator,
 - at least one kind of compounds selected from among halides and aluminum compounds as a material of a co-activator,
 - at least one kind of compounds selected from among alkaline earth metal oxides and compounds that change into alkaline earth metal oxides when fired, and
 - a halide or halides serving as a crystal growing agent;
 - an intermediate manufacturing process for producing an intermediate by washing, filtrating, and drying a fired substance resulting from the primary firing process;
 - a secondary firing process for crystal transformation of a part of the intermediate produced from the intermediate manufacturing process **wherein at least part of said intermediate is crystal transformed from an α -crystal structure to a β -crystal structure, by copper sulfate (CuSO_4) and/or zinc sulfate (ZnSO_4) being mixed with said intermediate;**
 - and
 - an etching process for etching the intermediate fired by the secondary firing process.
3. (Currently Amended) An electroluminescent phosphor production method as claimed in claim 2, wherein **in the primary firing process:**
 - magnesium oxide (MgO) is used as an alkaline earth metal oxide, and
 - at least one of the compounds selected from among magnesium carbonate (MgCO_3), basic magnesium carbonate, calcium carbonate (CaCO_3), calcium hydroxide ($\text{Ca}(\text{OH})_2$),

strontium carbonate (SrCO_3), strontium nitrate ($\text{Sr}(\text{NO}_3)_2$), barium carbonate (BaCO_3), and barium oxalate (BaC_2O_4) is used as a compound that changes into an alkaline earth metal oxide when fired.

REMARKS

Pursuant to 37 C.F.R. §1.111, reconsideration of the instant application, as amended herewith, is respectfully requested. Entry of the amendment is requested.

Claims 1-3 are presently pending before the Office. No claims have been canceled. Applicant has amended the claims. No new matter has been added. Support for the amendments can be found throughout the specification as originally filed, and in particular at Page 11. Applicant is not intending in any manner to narrow the scope of the originally filed claims.

The Examiner's Action mailed April 7, 2005, has been carefully studied by Applicant and the undersigned counsel. The amendments appearing herein and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is believed to be in condition for allowance.

The examiner notes that the declaration submitted on May 14, 2004 is defective. In accordance with applicant's discussion with the examiner when she telephoned the undersigned to inquire if the application had been abandoned, the examiner was advised that the declaration was merely a duplicate but executed version of the same declaration filed with the original application. The executed declaration was in response to the missing parts requirements. The use of the term "supplemental" may have been misleading. Although the examiner indicated that she would waive the requirement to file another declaration, applicant notes that herein, all three claims are being amended. Therefore, another declaration is herein being submitted to accompany the amendment herein.

Relying on 35 U.S.C. §112, first paragraph, the Examiner has rejected the subject matter of claim 2. The Examiner alleges that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims. On a similar note the Examiner has rejected claim 2 based on 35 U.S.C. §112, second paragraph. The rationale for both rejections was based on the transformation language not originally included in the claim. Applicant has amended the claim 2 herein to include language addressing the issue raised by the examiner. Withdrawal of both rejections is respectfully requested.

Relying on 35 U.S.C. §112, second paragraph, the examiner has rejected the subject matter of claims 1 and 3 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Regarding claim 1, the claim is amended as suggested by the examiner.

Regarding claim 3, applicant has amended the claim to clarify scope of the claim. "In the primary process" has been added to make it clear that the claim is defining the components actually used in the process, i.e., MgO and at least the compounds in claim 3 must be the alkaline earth compounds. In addition, the compounds enumerated in claim 3 are not examples, but the limitative listing.

It is respectfully submitted that claims 1-3, as amended, fully comply with 35 U.S.C. §112, second paragraph. Withdrawal of the rejections is respectfully requested.

CONCLUSION

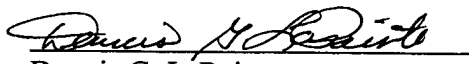
Even though the initial claims in this important patent application were drawn to a new, useful and nonobvious invention, they have now been amended to increase their specificity of language. Applicant respectfully submits that claims 1-3 are patentable over the art of record.

A Notice of Allowance is earnestly solicited.

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 943-9300 would be appreciated.

Very respectfully,

Dated: 1/25/06


Dennis G. LaPointe
LaPointe Law Group, P.L.
P.O. Box 1294
Tarpon Springs, FL 34688-1294
(727) 943-9300
Reg. No. 40,693

Customer No. 24040



COMBINED DECLARATION AND POWER OF ATTORNEY

(ORIGINAL, DESIGN, NATIONAL STAGE OF PCT, SUPPLEMENTAL, DIVISIONAL,
CONTINUATION, OR C-I-P)

As a below named inventor, I hereby declare that:

TYPE OF DECLARATION

This declaration is for a supplemental application.

INVENTORSHIP IDENTIFICATION

My residence, post office address and citizenship are as stated below, next to my name. I believe that I am an original, first and joint inventor of the subject matter that is claimed, and for which a patent is sought on the invention entitled:

TITLE OF INVENTION

ELECTROLUMINESCENT PHOSPHOR AND ITS PRODUCTION METHOD

SPECIFICATION IDENTIFICATION

The specification was filed on February 10, 2004, as Serial No. 11/775,862.

SUPPLEMENTAL DECLARATION (37 C.F.R. § 1.67(b))

I hereby declare that the subject matter of the amendment filed on December 28, 2005 was part of my/our invention and was invented before the filing date of the original application, above identified, for such invention.

ACKNOWLEDGMENT OF REVIEW OF PAPERS AND DUTY OF CANDOR

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information, which is material to patentability as defined in 37, Code of Federal Regulations, § 1.56, and which is material to the examination of this application, namely, information where there is a substantial likelihood that a reasonable Examiner would consider it important in deciding whether to allow the application to issue as a patent.

PRIORITY CLAIM (35 U.S.C. §§ 119(a)-(d), (f) 172, and 365(a) and (b))

I hereby claim foreign priority benefits under Title 35, United States Code, §§ 119(a)-(d) of any foreign application(s) for patent or inventor's certificate or of any PCT international application(s) designating at least one country other than the United States of America listed below and have also identified below any foreign application(s) for patent or inventor's certificate or any PCT international application(s) designating at least one country other than the United States of America filed by me on the same subject matter having a filing date before that of the application(s) of which priority is claimed.

Such applications have been filed as follows.

**PRIOR FOREIGN APPLICATION(S) FILED WITHIN 12 MONTHS
(6 MONTHS FOR DESIGN) PRIOR TO THIS APPLICATION
AND ANY PRIORITY CLAIMS UNDER 35 U.S.C. § 119(a)-(d)**

COUNTRY	APPLICATION NUMBER	DATE OF FILING DAY, MONTH, YEAR	PRIORITY CLAIMED UNDER 37 U.S.C. SECTION 119
JP	2003-034114	12 February 2003	yes

POWER OF ATTORNEY

I hereby appoint the practitioner(s) associated with Customer Number 24040 to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

SEND CORRESPONDENCE TO

CUSTOMER NUMBER 24040
LAPOINTE LAW GROUP, PL
P.O. BOX 1294
TARPON SPRINGS, FL 34688

DIRECT TELEPHONE CALLS TO:

DENNIS G. LAPOINTE
727-943-9300

DECLARATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

SIGNATURE(S)

Junya WATABE

Inventor's signature

Date Dec. 20, 2005

Residence Kanagawa JAPAN

Post Office Address #8 Kouyousou, 1-14, Nishi-yawata 4-Chome, Hiratsuka-shi,
Kanagawa 254-0073 JAPAN

Junya Watabe
Country of Citizenship JAPAN


Yoshiki KANNO

Inventor's signature Yoshiki KANNODate DEC. 20, 2005 Country of Citizenship JAPAN

Residence Kanagawa JAPAN

Post Office Address #7 Kouyousou, 1-14, Nishi-yawata 4-Chome, Hiratsuka-shi,
Kanagawa 254-0073 JAPAN

Shigenobu MATSUMURA

Inventor's signature Date Dec. 21, 2005 Country of Citizenship JAPAN

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Post Office Address 4-7, Kamitsuruma 2-chome, Sagamihara-shi,
Kanagawa 228-0802 JAPAN